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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): James S. McCormick, et al.

Title: METHOD AND APPARATUS FOR PROCESSING CALL
SIGNALING MESSAGES

App. No.: 09/246,612

Filed: 02-08-1999

Examiner: Tang, Kenneth

Group Art Unit: 2195

Atty. Dkt. No. 1400.9801020

Mail Stop PETITION
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(a)

Dear Sir:

The Office acknowledges a petition under 37 CFR 1.47(a) was filed August 30, 1999, noting a certificate of mailing date of August 25, 1999. On March 20, 2006, the Office mailed a copy of the decision on the petition, whereby the Office dismissed the petition.

The Office states, in the decision on the petition, that the petition lacks "a proper oath or Declaration executed by the available joint inventor(s)" and "the last known address of the omitted inventor(s)." The Office states, "The declaration does not contain required information for Mr. Furshpan. His residence, post office address and citizenship are missing. As listing each inventor's citizenship in the declaration is a statutory requirement under 35 U.S.C. 115, it cannot be waived." The Office further states, "The signing inventors must execute another declaration that lists the application serial number and filing date, contains the signers' own information, and lists the non-signer's information, including citizenship. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventors is REQUIRED. See MPEP 409.03(a)." The Office also states, "...a statement of the last known address of the omitted inventor is missing and is required."

Applicant submits herewith an unsigned supplemental declaration including information pertaining to the non-signing inventor but not included in the previously filed declaration. Applicant states, upon information and belief, the non-signing inventor's last known address is as follows:

David Furshpan
Sokolov 9 Apt. #26
Kfar Saba, 44256
Israel

Applicant notes 35 U.S.C. § 115 states, "The **applicant** shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country **he** is a citizen...[emphasis added]." Applicant submits the distinction between "inventor" and "applicant" arises in the context of 37 C.F.R. § 1.47, such that the "inventor" may not be identical to the "applicant." For example, in the present application, as Mr. Furshpan has not "joined in" the application, Applicant submits Mr. Furshpan is not an "applicant." While the Office states, "...listing each inventor's citizenship in the declaration is a statutory requirement under 35 U.S.C. 115...", Applicant submits the 35 U.S.C. 115 imposes a duty upon the "applicant," instead of the "inventor." Applicant submits the inventors who have joined in the application have stated of what country they are citizens. Thus, Applicant submits the previously filed declaration complies with the requirements of 35 U.S.C. § 115.

Moreover, regardless of the foregoing argument, Applicant notes, in *Autovox, S.p.A. v. Lenco Italiana, S.p.A.*, 208 USPQ 412, 415 (N.D. Ill. 1980), regarding the applicant's failure to state his citizenship in the declaration, the court stated, "This court is disinclined to invalidate a patent for a reason the Patent Office deems a minor technicality." Thus, Applicant submits the previously filed declaration is in substantial compliance with the requirements of 35 U.S.C. § 115 and Patent Office practice.

Furthermore, Applicant notes 37 C.F.R. § 1.67(a)(2) states, "Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates." As the Office states, "The declaration does not contain required information for Mr. Furshpan," Applicant submits any "deficiencies" are limited to those "relating to" only Mr. Furshpan. However, as the Office notes,

Applicant submits Mr. Furshpan is the non-signing inventor. Thus, it was not possible to obtain Mr. Furshpan's signature, but rather Applicant has attempted to proceed under the provisions of 37 C.F.R. 1.47(a). Moreover, Applicant submits 37 C.F.R. § 1.67(a)(2) specifically contemplates situations arising under § 1.47, as it cites "§ 1.47" following "inventor(s) or applicant(s)." Accordingly, Applicant submits herewith, an unsigned supplemental declaration identifying the entire inventive entity but unsigned, as Applicant submits the only inventor to whom the deficiency relates refuses to join or cannot be found or reached after diligent effort. Thus, Applicant submits the enclosed unsigned supplemental declaration complies with 37 C.F.R. §§ 1.47(a) and 1.67(a)(2).

As noted above, the Office states, "An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventors is REQUIRED. See MPEP 409.03(a)." Applicant submits the previously filed declaration was intended to comply with MPEP § 409.03(a), 37 C.F.R. §§ 1.63 and 1.64, and Rule 1.47. To the extent the Office contends the previously filed declaration is deficient, Applicant submits 37 C.F.R. § 1.67 specifically provides for the Office to prescribe submission of a supplemental oath or declaration "...to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration...." Thus, Applicant submits the enclosed supplemental declaration complies with the relevant rules.

Respectfully submitted,

Date

10/20/2006



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